

15th Annual Advanced Patent Law Institute - Austin
October 28-29, 2010 • Four Seasons Hotel • Austin, TX

Thursday Morning, Oct. 28, 2010

Presiding Officer:

Alan D Albright, Bracewell & Giuliani LLP - Austin, TX

8:00 am	Registration Opens Includes continental breakfast.
8:50 am	Welcoming Remarks
9:00 am 0.33 hr	Patent Prosecution: The PTO's Use of Prior Art Submissions A short look at some recent empirical results on what examiners do (and don't) pay attention to. Mark A. Lemley, Stanford Law School - Stanford, CA
9:20 am 0.50 hr	Claims Drafting Strategies and Prosecution Issues Patent prosecutors spend every day drafting and prosecuting claims to ensure that they comply with Sections 101, 102, 103 and 112. Further, most—but unfortunately not all—know how to avoid mistakes that result in an unnecessarily narrow claim construction. Often overlooked, however, are the steps a patent prosecutor can take to maximize a damages award or capture a direct infringer so his client faces fewer hurdles in proving infringement at trial. This presentation, based on the latest decisions from the Federal Circuit, shows how careful drafting and prosecution of patent applications can avoid the lesser-known, but often fatal, problems that patentees face in patent litigation. Materials By: Erik R. Puknys, Finnegan, Henderson, Farabow, Garrett & Dunner, LLP - Palo Alto, CA Mark D. Sweet, Finnegan, Henderson, Farabow, Garrett & Dunner, LLP - Washington, DC
9:50 am 0.50 hr	Claim Construction: Play Continues Claim construction remains the engine driving the patent train, both in preparation and prosecution, and in litigation. As Federal Circuit personnel change, does precedent change claim construction "in the field," despite <i>Phillips</i> ? Discussion of the year's cases is focused on that question. Kenneth R. Adamo, Jones Day - Dallas, TX
10:20 am	Break
10:35 am 0.50 hr ethics	Inequitable Conduct After years of differing opinions, the Federal Circuit will consider en banc the standards to apply to inequitable conduct in <i>Therasense v. Becton Dickinson</i> . The presentation covers the need for en banc review, the issues raised in <i>Therasense</i> and possible outcomes. Darryl J. Adams, Baker Botts L.L.P. - Austin, TX

11:05 am 0.50 hr	ITC Update It is the new favorite forum for non-practicing entities—the bar for entry has been lowered and the threat of an injunction has increased. David M. Maiorana, Jones Day - Cleveland, OH
11:35 am 0.75 hr	Patentable Subject Matter: Back in the Federal Circuit's Court In <i>Bilski</i> , the Supreme Court reaffirmed the bar against patenting “abstract ideas” while rejecting the exclusivity of a machine-or-transformation test for process patentability. Also in 2010, a district court judge ruled that claims for isolated genetic sequences and their diagnostic use lacked patentable subject matter. Where might the law go from here and how might private parties react? John M. Golden, The University of Texas School of Law - Austin, TX Mark A. Lemley, Stanford Law School - Stanford, CA

Thursday Afternoon, Oct. 28, 2010

Presiding Officer:

Brent K. Bersin, Navigant Consulting, Inc. - Houston, TX

12:20 pm	Lunch on your Own
1:30 pm 0.50 hr	Navigating Injunctions and Motions for Contempt: Effective (and Ineffective) Design-Around Strategies A summary of cases involving post-judgment enforcement of injunctions, contempt proceedings and new infringement actions. The discussion includes the en banc hearing in <i>TiVo v. EchoStar</i> (Fed. Cir. 2010) and suggested strategies for wording injunctions, for enforcing injunctions, and for designing around patents and injunctions. Tom Adolph, Jackson Walker LLP - Houston, TX
2:00 pm 0.50 hr	Surveys in Patent Litigation: Use or Abuse? The use of surveys in patent litigation to attempt to prove direct infringement and damages appears to be a growing trend. This presentation examines why plaintiffs may choose this path, discovery issues relating to patent surveys, and issues relating to the use and admissibility of patent surveys at trial. Kevin Sean Kudlac, Weil, Gotshal & Manges LLP - Houston, TX
2:30 pm 0.50 hr	Grey Markets: Costco and its Potential Implications for Copyright and Patent Exhaustion The Supreme Court has granted certiorari in <i>Costco Wholesale Corp. v. Omega, S.A.</i> to decide whether the "first-sale doctrine" in U.S. copyright law applies to imported goods that have been made abroad by the copyright owner. And in <i>Fujifilm Corp. v. Benun</i> , the Federal Circuit recently held that the Supreme Court's decision in <i>Quanta</i> did not eliminate the territoriality requirement for patent exhaustion. This presentation examines the potential impact of <i>Costco</i> on copyright and patent exhaustion, including the territoriality requirement for both. Douglas W. McClellan, Weil, Gotshal & Manges LLP - Houston, TX
3:00 pm	Break

3:15 pm 0.50 hr	<p>Damages, Part I: Legal Developments in Licensing Issues, Apportionment and Reasonable Royalties</p> <p>With district courts, the Federal Circuit and Congress taking aim at a wide range of patent damages issues recently, including <i>Georgia-Pacific</i> factors, the EMVR, customer demand, licenses and settlements, and the competency and sufficiency of expert testimony, many questions have been raised about how clients and practitioners should approach damages claims now, and the kinds of evidentiary support and economic proof that may be required for damages awards capable of surviving scrutiny at every level.</p> <p>Bruce S. Sostek, Thompson & Knight LLP - Dallas, TX</p>
3:45 pm 0.75 hr	<p>Damages, Part II: Litigation Strategies</p> <p>Two experienced patent trial attorneys, along with experienced financial testifying experts, use a point-counterpoint format to discuss new approaches to presenting and defending damages in patent cases that have emerged in the wake of several recent Federal Circuit rulings curtailing damages in patent cases. Topics include apportioning the value of the claimed features, analyzing and applying license agreements, handling assertions of non-infringing alternatives, and other economic and trial issues related to patent damages.</p> <p>Stephen L. Becker, Applied Economics Consulting Group, Inc. - Austin, TX Brett C. Govett, Fulbright & Jaworski L.L.P. - Dallas, TX W. Todd Schoettelkotte, FTI Consulting, Inc. - Houston, TX Theodore Stevenson III, McKool Smith, P.C. - Dallas, TX</p>
4:30 pm 1.00 hr 0.50 hr ethics	<p>Judicial Panel</p> <p>Distinguished judges discuss their experiences with, and thoughts on, managing, hearing and trying patent cases.</p> <p>Moderator: Alan D Albright, Bracewell & Giuliani LLP - Austin, TX Panelists: Hon. Nancy F. Atlas, U.S. District Court, Southern District of Texas - Houston, TX Panelists: Hon. W. Royal Furgeson Jr., U.S. District Court, Northern District of Texas - Dallas, TX Panelists: Hon. Barbara M.G. Lynn, U.S. District Court, Northern District of Texas - Dallas, TX Panelists: Hon. T. John Ward, U.S. District Court, Eastern District of Texas - Marshall, TX</p>
5:30 pm	<p>Adjourn</p>

Friday Morning, Oct. 29, 2010

Presiding Officer:

James D. Woods, UHY Advisors FLVS, Inc. - Houston, TX

8:00 am	<p>Conference Room Opens</p> <p>Includes continental breakfast.</p>
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8:30 am 0.50 hr ethics	<p>Litigation Holds and Spoliation</p> <p>A brief discussion of document retention requirements, hold notices, spoliation and related legal and ethical obligations.</p> <p>Peter M. Roossien, Freescale Semiconductor, Inc. - Austin, TX Barry K. Shelton, Bracewell & Giuliani LLP - Austin, TX</p>
9:00 am 0.50 hr	<p>Design Patent Litigation Post-Egyptian Goddess</p> <p>The Federal Circuit's decision to eliminate the "point of novelty" element of design patent infringement proof was the first of a litany of district court and Federal Circuit decisions that impact the way in which design patents now are procured and litigated. This presentation examines recent design patent case law and provides practical tips on design patent litigation <i>Post-Egyptian Goddess</i>.</p> <p>Christopher J. Renk, Banner & Witcoff, Ltd. - Chicago, IL</p>
9:30 am 0.50 hr ethics	<p>Ethics Issues Relating to Patent Practice</p> <p>The presentation addresses recent developments in both legal malpractice and conflicts (disqualification) cases which arise out of patent prosecution and litigation, and offers a few practical tips for minimizing your risk of finding yourself in either situation.</p> <p>Ragesh K. Tangri, Durie Tangri LLP - San Francisco, CA</p>
10:00 am	<p>Break</p>
10:15 am 0.50 hr ethics	<p>Disqualification Motions</p> <p>Overlooking procedural issues that accompany a motion to disqualify can have a serious impact. This session describes issues concerning standing, which rules apply in state and federal court and the roles they play, the impact of disqualification on existing work product, and the question of appealability.</p> <p>David Hricik, Mercer University School of Law - Macon, GA</p>
10:45 am 0.50 hr	<p>Corporate Patent Strategy: Portfolio Management, Monetization and M&A Issues</p> <p>Patents exist for one reason ... money. If a patent isn't making money for a patent owner, either directly or indirectly, then patents aren't worth the expense. To ensure an adequate return for patent assets, patent owners must develop a comprehensive strategy that governs all patent operations, from patent selection/creation, patent portfolio management and patent monetization to asset M&A. Do you (or your clients) have a strategy that is the lighthouse for all your patent operations?</p> <p>Keith E. Witek, Advanced Micro Devices, Inc. - Austin, TX</p>
11:15 am 0.75 hr	<p>Patent Pools Standards and Patent Misuse</p> <p>Patent misuse generally requires a showing of market power, yet with the persuasive use of patent pools to license de facto or de jure standards, as well as the establishment of licensing companies that administer both patent pools and private portfolios, market power is easier to prove and the focus is now on the actual conduct and its consequences.</p> <p>David J. Healey, Fish & Richardson P.C. - Houston, TX</p>

Friday Afternoon, Oct. 29, 2010

Presiding Officer:

Robert L. King, Silicon Laboratories - Austin, TX

	LUNCHEON PRESENTATION Sponsored by Bracewell & Giuliani LLP
12:00 pm	Pick up Box Lunch Included in conference registration fee.
12:15 pm 0.75 hr	Alternative Fee Arrangements and Effective In-House Management Taking charge of legal costs in a challenging market environment requires changes in the way legal services have been traditionally provided. This panel of in-house counsel discusses strategies for managing the costs associated with handling patent-related matters and provides insight into changes occurring in the profession. Moderator: Jennifer B. Wuamett, Freescale Semiconductor, Inc. - Austin, TX Panelists: Lance A. Jones, Trilogy - Austin, TX Panelists: James T. Sullivan, FMC Technologies Inc. - Houston, TX
1:00 pm	Break
1:15 pm 0.75 hr	Strategic Reexams: Top 10 Issues The interplay between reexam and litigation creates issues that must be dealt with strategically in each proceeding. Discussed are real life examples of how cases play out regarding the decision to file; joint defense groups; timing considerations including stays, "late" filings, and pendency; judicial views of events in reexam and vice-versa; Office Action Responses and use of declarations; the impact of allowed claims and intervening rights; petition practice; and appeals to the BPAI. Moderator: David L. McCombs, Haynes and Boone, LLP - Dallas, TX Panelists: Tracy W. Druce, Novak Druce + Quigg LLP - Houston, TX Panelists: Jerald 'Jerry' Gnuschke, Microsoft - Redmond, WA Panelists: Kevin James Meek, Baker Botts L.L.P. - Austin, TX
2:00 pm 0.50 hr	Venue Transfers in Patent Cases Venue plays an important role in the outcome of patent litigation. This session analyzes recent Federal Circuit and Texas district court venue cases to determine what tactics parties are using to deal with the changed landscape of patent venue, and how courts are reacting to them. Michael C. Smith, Siebman, Burg, Phillips & Smith, LLP - Marshall, TX

2:30 pm
0.50 hr

False Patent Marking Suits

The trends, latest case law, legislative developments, risks and preventative measures.

Steven J. Pollinger, McKool Smith, P.C. - Austin, TX

3:00 pm

Adjourn